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10/773,761	02/06/2004	Mark G. Erlander	022041-001420US	5596
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Patentique PLLC P.O. Box 5803 Bellevue, WA 98006			BERTAGNA, ANGELA MARIE	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/773,761

Applicant(s)

ERLANDER ET AL.

Examiner

Angela M. Bertagna

Art Unit

1637

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-8, 10-16, 18-25, 27-38, 42, 49, 50, 52-63 and 67-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-8, 10-16, 18-25, 27-38, 42, 49, 50, 52-63 and 67-70 is/are rejected.
- 7) ☒ Claim(s) 12, 35, 49, 50, 52-57, 59, 60 and 67-70 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
Paper No(s)/Mail Date: _____
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

1. Applicant's response filed on November 30, 2009 is acknowledged. Claims 6-8, 10-16, 18-25, 27-38, 42, 49, 50, 52-63, and 67-70 are currently pending. In the response, claims 6, 7, 9, 11-15, 17-21, 23, 24, 26-30, 32, 35-38, 42, 49, 50, 52-57, and 60 were amended, and claims 9, 17, and 26 were canceled.

The following include new grounds of rejection. Any previously made rejections or objections not reiterated below have been withdrawn. Applicant's arguments that remain pertinent to the new grounds of rejection have been fully considered, but they were not persuasive for the reasons set forth in the "Response to Arguments" section. Since the new grounds of rejection presented in sections 5-7 below were not entirely necessitated by Applicant's amendment, this Office Action is made **NON-FINAL**.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original non-provisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35

U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

In this case, the disclosure of the prior-filed application, Provisional Application No. 60/504,087, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for all of the pending claims in the instant application. The '087 application does not provide adequate support for the requirement in all of the instant claims to determine the ratio of HoxB13 and IL17BR RNA expression levels. Also, as discussed in greater detail in section 5 below, neither of the prior-filed applications (*i.e.*, non-provisional Application Serial No. 10/727,100 and Provisional Application No. 60/504,087) provide adequate support for determining the average HoxB13:IL17BR mRNA expression level ratio using the average HoxB13 and IL17BR mRNA expression levels in ER+ breast cancer cells obtained from human breast cancer patients that respond to treatment with an antiestrogen agent and from human breast cancer patients that do not respond to treatment with the antiestrogen agent as required by all of the pending claims in the instant application. Accordingly, benefit of the prior-filed '087 and '100 applications has not been granted, and the filing date of the instant application, **(February 6, 2004)** has been used for prior art purposes.

Claim Objections

3. Claim 12 is objected to because of the following informalities: The recitation "is comprises" in line 2 is grammatically incorrect.

Claim 35 is objected to because of the following informalities: Replacing "IL17BR RNA" in line 2 with "IL17BR mRNA" is suggested to improve consistency with claim 32.

Claim 59 is objected to because of the following informalities: Replacing "said expression level(s)" with "said RNA expression level(s)" is suggested to improve consistency with claim 32.

Claims 67-70 are objected to because of the following informalities: The status identifiers listed for these claims are incorrect. These claims should be listed as "previously presented".

Appropriate correction is required.

Claims 49, 50, and 52-57 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims are drawn to the method of claims 6, 14, 23, or 32, wherein expression of a particular IL17BR and HoxB13 sequence is determined. Claims 49, 50, and 52-57 encompass determination of protein expression levels or RNA expression levels, and therefore, they are broader in scope than the methods of claims 6, 14, 23, and 32, which are limited to RNA expression levels.

Claim 60 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 60 is drawn to the method of claim 32, wherein "said assaying comprises determining the expression levels of HoxB13 and/or IL17BR mRNAs". Claim 60 fails to further limit the method of claim 32, because claim 32 already recites determining the expression levels of HoxB13 and/or IL17BR mRNAs.

Claim Rejections - 35 USC § 112, 2nd paragraph

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38, 42, 49, 50, 52-57, 60-63, and 70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 38, 49, 50, 52-57, and 60-63 are indefinite, because there is insufficient antecedent basis for the limitation "said assaying", which is recited in line 1 of the claims.

Claims 42 and 70 are indefinite, because claim 42, from which claim 70 depends, recites the limitation "said ratio of HoxB13 and IL17BR RNA expression levels" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 112, 1st paragraph (New Matter)

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-8, 10-16, 18-25, 27-38, 42, 49, 50, 52-63, and 67-70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection.**

MPEP 2163.03 states, "An amendment to the claims or the addition of a new claim must be supported by the description of the invention in the application as filed." *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989). MPEP 2163.05 states, "If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph - written description requirement." *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

These claims are drawn to methods of using the ratio of HoxB13:IL17BR mRNA expression levels measured in a sample of breast cancer cells obtained from an estrogen receptor positive (ER+) breast cancer patient to assess the subject's responsiveness to an antiestrogen agent, such as tamoxifen, and thereby, predict the subject's risk of cancer recurrence. The claims recite that the HoxB13:IL17BR mRNA expression level ratio is compared to an average HoxB13:IL17BR mRNA expression level ratio to assess the subject's responsiveness and predict the risk of cancer recurrence. The claims further recite that the average HoxB13:IL17BR mRNA expression level ratio is determined from the average HoxB13 and IL17BR mRNA expression levels in ER+ breast cancer cells obtained from human breast cancer patients that respond to treatment with an antiestrogen agent and from human breast cancer patients that do not respond to treatment with the antiestrogen agent. Applicant states that the limitation finds support throughout the application as filed and, in particular, at Figures 3, 6, and 7 of Application Serial No. 10/727,100, to which the instant application claims priority and which has been expressly incorporated by reference (see page 11 of the response filed on May 18, 2009).

The original disclosure, including the disclosure of the incorporated '100 application, has been carefully reviewed, but it does not appear to provide adequate support for the claimed

method of determining the average HoxB13:IL17BR mRNA expression level ratio. The instant application and the incorporated '100 application appear to provide proper support for the following (see Figure 2a-2d and Examples 3-4 of the instant application; see also Figures 3, 6, and 7 of the '100 application, which were cited by Applicant as providing support for the claimed limitation): (i) measuring HoxB13 & IL17BR mRNA expression levels in samples obtained from a cohort or "training set" of breast cancer patients known to be "tamoxifen responders" and "tamoxifen non-responders" and determining the HoxB13:IL17BR ratio for each sample, (ii) conducting a logistic regression analysis to determine a cutoff point that accurately classifies the patients in the cohort as "responders" or "nonresponders" based on the measured HoxB13:IL17BR expression ratio, (iii) measuring the HoxB13 and IL17BR expression levels in a sample obtained from an ER+ breast cancer patient and determining the ratio of HoxB13:IL17BR mRNA, and (iv) classifying the patient as a tamoxifen responder or a tamoxifen non-responder by comparing the measured HoxB13:IL17BR ratio to the cutoff ratio, wherein a ratio higher than the cutoff ratio indicates a tamoxifen non-responder and a ratio lower than the cutoff ratio indicates a tamoxifen non-responder. It is not clear from the original disclosure that that an average HoxB13:IL17BR ratio was calculated from the average HoxB13 and IL17BR mRNA expression levels in ER+ breast cancer cells obtained from human breast cancer patients that respond to treatment with an antiestrogen agent and from human breast cancer patients that do not respond to treatment with the antiestrogen agent as required by the instant claims. Accordingly, claims 6-8, 10-16, 18-25, 27-38, 42, 49, 50, 52-63, and 67-70 have been rejected for incorporating new matter.

Claim Rejections - 35 USC § 112, 1st paragraph (Enablement)

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-8, 10-16, 18-25, 27-38, 42, 49, 50, 52-63, 68, and 70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Enablement is considered in view of the Wands factors (MPEP 2164.01(A)). These include: (1) the nature of the invention, (2) the breadth of the claims, (3) guidance of the specification, (4) the existence of working examples, (5) state of the art, (6) predictability in the art, and (7) the amount of experimentation necessary and the relative skill levels of those in the art.

Nature of the Invention:

Claims 6-8, 10-13, 49, 50, 58, and 61 are drawn to a method of determining the risk of cancer recurrence in a human subject afflicted with ER(+) breast cancer based on the observed ratio of HoxB13 and IL17BR RNA expression levels. Claims 14-16, 18-22, 52, 53, 62, and 68 are drawn to a method of determining the clinical outcome of a human subject afflicted with ER(+) breast cancer an treated with an antiestrogen agent based on the observed ratio of HoxB13 and IL17BR RNA expression levels. Claims 23-25, 27-31, 54, 55, and 63 are drawn to a method of predicting the response of a human subject afflicted with ER(+) breast cancer to an

antiestrogen agent based on the observed ratio of HoxB13 and IL17BR RNA expression levels. Claims 32-38, 42, 56, 57, 59, 60, and 70 are drawn to a method of determining the risk of cancer recurrence in a human subject afflicted with ER(+) breast cancer if treated with an antiestrogen agent based on the observed ratio of HoxB13 and IL17BR expression levels. The claimed methods are classified in the unpredictable arts of chemistry and biology.

Breadth of the claims:

The claims are extremely broad in scope. The methods of claims 6-8, 10-13, 58, and 61 encompass determining the risk of cancer recurrence or clinical outcome in ER(+) breast cancer human subjects of any age, ethnic population, and gender based solely on the observed ratio of the mRNA expression levels of any HoxB13 sequence and any IL17BR sequence, where any expression level ratio higher than the average ratio of HoxB13 and IL17BR RNA expression levels in ER(+) breast cancer cells is indicative of cancer recurrence. Claims 49 and 50 further limit the HoxB13 and IL17BR sequences to SEQ ID NO: 6 and SEQ ID NO: 1, respectively.

Claims 14-16, 18-22, and 62 encompass determining the clinical outcome in human subjects of any age, ethnic population, and gender based solely on the observed ratio of the mRNA expression levels any HoxB13 sequence and any IL17BR sequence, where any expression level ratio higher than the average ratio of HoxB13 and IL17BR RNA expression levels in ER(+) breast cancer cells is indicative of cancer recurrence. The methods of claims 14-16, 18-22, and 62 are also not limited to patients having ER(+) breast cancer and comprise determining the clinical outcome for any human subject afflicted with any type of breast cancer following treatment of the subjects with any antiestrogen agent. Claims 52 and 53 further limit

the HoxB13 and IL17BR sequences to SEQ ID NO: 6 and SEQ ID NO: 1, respectively, and claim 68 further limits the antiestrogen agent to tamoxifen.

The methods of claims 23-25, 27-31 and 63 encompass predicting the response of ER(+) breast cancer human subjects of any age, ethnic population, and gender to treatment with any antiestrogen agent based solely on the observed ratio of the mRNA expression levels any HoxB13 sequence and any IL17BR sequence, where any expression level ratio higher than the average ratio is indicative of a negative response to treatment. Claims 54 and 55 further limit the HoxB13 and IL17BR sequences to SEQ ID NO: 6 and SEQ ID NO: 1, respectively.

The methods of claims 32-38, 42, 59, and 60 encompass determining the risk of cancer recurrence in human ER(+) breast cancer subjects of any age, ethnic population, and gender if treated with any antiestrogen agent based solely on any observed increase in the RNA or protein expression levels of any HoxB13 sequences (*i.e.*, wild-type or any variant sequence) or any observed decrease in the RNA or protein expression levels of any IL17BR sequences (*i.e.*, wild-type or any variant sequence). Claims 56 and 57 further limit the HoxB13 and IL17BR sequences to SEQ ID NO: 6 and SEQ ID NO: 1, respectively, and claim 70 further limits the antiestrogen agent to tamoxifen.

Guidance of the specification and Working Examples:

The specification teaches that the ratio of HoxB13 and IL17BR RNA expression can be used to determine a risk of cancer recurrence, predict clinical outcome, and predict the responsiveness of any human subject to treatment with an antiestrogen agent (see, for example, pages 9-12 and 55). The specification also teaches that any change in the ratio compared to a

control or baseline ratio is sufficient for prediction and risk assessment (see pages 17-18, for example). The specification further teaches that the methods can be used to predict the responsiveness of a subject to any antiestrogen agent (see pages 15-16, for example). Finally, the specification provides a number of HOXB13 and IL17BR sequences and teaches that "any sequence, or unique portion thereof, of the following IL17BR sequence, identified by AF208111 or AF208111.1, may be used in the practice of the invention" and goes on to disclose the IL17BR sequence of SEQ ID NO: 3 (see pages 34, lines 2-4 and SEQ ID NO:3 on page 34-35). Similarly, the specification teaches that "any sequence encoding all or part of the protein encoded by any IL17BR sequence disclosed herein may be used (page 29, lines 4-10)."

In Example 1, the specification teaches that a 22,000-gene high-density oligonucleotide microarray was used to determine gene expression patterns from 60 ER+ breast cancer patients who were uniformly treated with tamoxifen (see page 60, line 20 - page 61, line 14). The IL17BR and HOXB13 oligonucleotide sequences used in the microarray are undisclosed. In Example 2, the specification teaches that from the resulting data set, 5,475 genes were selected for further analysis and that using this reduced dataset, a t-test was performed on each gene comparing "the tamoxifen responders and non-responders, leading to identification of 19 differentially expressed genes at the P value cutoff of 0.001 (Table 2)", including HOXB13 and IL17BR (see page 65, lines 5-15). Then, to further refine the analysis, the specification teaches that the same cohort was reanalyzed following laser-capture microdissection of tumor cells within each tissue section and 9 differentially expressed gene sequences were identified with P0.001, again including HOXB13 and IL17BR (see page 66, lines 2-6 and Table 3). The specification teaches that HOXB13, IL17BR, and CACNAID expression levels were found to be significantly correlative

in both the LCM and whole tissue section samples (see, *e.g.*, page 67, lines 3-10). The specification further states that "...these three genes have potential utility for predicting clinical outcome of adjuvant tamoxifen therapy (page 68, lines 6-7)." Finally, the specification discloses that the HOXB13 and IL17BR expression ratio is a "strong independent predictor of treatment outcome in the setting of adjuvant tamoxifen therapy (see, *e.g.*, page 70, lines 5-7)."

However, the working examples do not teach the use of the HOXB13 and IL17BR expression ratio outside the setting of adjuvant tamoxifen therapy and ER+ breast cancer patients (*e.g.* to predict a risk of cancer recurrence or the responsiveness of a subject having any other type of breast cancer to any other antiestrogen agent). The specification also does not teach what levels of mRNA expression of HOXB13 and IL17BR sequences are required such that the ratio is indicative of responsiveness to a particular treatment, clinical outcome, or the risk of cancer recurrence. The working examples also do not address the ability of the expression ratio to be used in different human populations (*e.g.* different ethnic populations, age groups, or male and female breast cancer patients) or whether the ratios of any different HoxB13 and IL17BR sequences can be used to predict the risk of cancer recurrence, clinical outcome, or responsiveness to antiestrogen treatment.

State of the Art and Unpredictability in the Art

In general, the art is underdeveloped with respect to the use of gene expression profiles to predict breast cancer outcome and does not teach the using the ratio of HoxB13:IL17BR mRNA expression levels to assess potential responsiveness to antiestrogen therapy, predict clinical outcomes, or to assess the risk of cancer recurrence.

The unpredictability of correlating a gene expression level to any phenotypic quality is taught in the prior art by Wu (Journal of Pathology (2001) 195(1):53-65; cited previously). Wu teaches that gene expression data must be interpreted in the context of other biological knowledge, involving various types of "post genomics" informatics, including gene networks, gene pathways, and gene ontologies (page 53, left column). The reference indicates that many factors may be influential to the outcome of data analysis, and teaches that expression data can be interpreted in many ways. The conclusions that can be drawn from a given set of data depend heavily on the particular choice of data analysis. Much of the data analysis depends on such low-level considerations as normalization and such basic assumptions as normality (page 63).

Additionally, the post-filing art reveals that most gene association studies are typically wrong. Lucentini (The Scientist, page 20, Dec. 20, 2004; cited previously) teaches that it is strikingly common for follow-up studies to find that previously reported gene-disease associations are wrong (left column, 3rd paragraph). Lucentini describes two recent studies, which reported that when a finding is first published linking a given gene to a disease there is usually only roughly a one-third chance that the study will reliably confirm the finding (left column, 3rd paragraph). Lucentini teaches that bigger sample sizes and more family-based studies, along with revised statistical methods should be included in the gene association studies (middle column, 1st full paragraph).

The lack of predictive success of gene expression studies may, in part, be due to the fact that increased mRNA is not always indicative of protein expression levels. Chen et al. (Molecular and Cellular Proteomics 1:304-313, 2002; cited previously) compared mRNA and protein expression for a cohort of genes in the same lung adenocarcinomas. Only 17% of 165

protein spots or 21% of the genes had a significant correlation between protein and mRNA expression levels. Chen stated that "the use of mRNA expression patterns by themselves, however, is insufficient for understanding the expression of protein products" (page 304) and "it is not possible to predict overall protein expression levels based on average mRNA abundance in lung cancer samples" (pages 311-312). Similarly, since it is well established in the art that single nucleotide substitutions can result radical alterations of gene expression, the ability of each of the different HoxB13 and IL17BR mRNA and protein sequences encompassed by the claims to function in the claimed methods is highly unpredictable.

Most significantly, the post-filing art of Ma et al. (Cancer Cell 5:607-616, 2004; cited previously) does report the use of HoxB13 and IL17BR to attempt to predict clinical outcome in breast cancer patients treated with tamoxifen. This study also discloses a study in which gene expression profiles of ER+ primary breast cancers treated with adjuvant tamoxifen therapy were generated (see entire document, especially the Abstract). However, Ma concluded that "[t]he observation that a simple expression ratio of two genes, HoxB13:IL17BR, accurately predicts tumor recurrence in adjuvant tamoxifen-treated patient with early-stage ER-positive breast cancer is limited by the size of patient cohorts" and that it "will require confirmation in a large population-based cohort" (paragraph bridging pages 612-613). Moreover, Ma stated that "it remains to be determined whether this two-gene ratio predicts a tumor's response to tamoxifen or its intrinsic aggressiveness, or both" and that a "similarly case-matched cohort of untreated patients will be required to address this issue" (ibid). This level of unpredictability is exacerbated by the fact that "little is known about the relevance of HoxB13 in breast cancer biology", and further that "[l]ittle information exists in the literature linking IL17BR to breast cancer" as

further taught by Ma (page 611, 2nd column, first full paragraph and page 613, 1st column, 1st full paragraph).

Based on these teachings in the cited references, it must be concluded that extension of the data presented in the working examples to cover the full scope of the claim (*i.e.* analysis of other antiestrogen agents, assessment of the risk of cancer recurrence, determination of clinical outcome, or tamoxifen responsiveness in any human subject population, *etc*) would be a highly unpredictable undertaking.

Quantity of Experimentation

The quantity of experimentation required in this case is immense, because it would require significant study and experimentation including trials with hundreds of patients to determine that the HoxB13/IL17BR RNA expression ratio recited in the claimed methods is capable of reliably functioning to determine the risk of cancer recurrence, assess clinical outcome, or predict the response of a particular human subject population to treatment with a single antiestrogen agent. The quantity of experimentation required to conduct the claimed methods would constitute an inventive, unpredictable, and difficult undertaking in itself, requiring years of inventive effort, with no guarantee of success at the conclusion. Furthermore, each of the different HoxB13 mRNA, IL17BR mRNA, antiestrogen agents, and subject populations encompassed by the claimed methods would require the same extensive trial-and-error type experimentation in order to determine the ability of the HoxB13:IL17BR ratio to be used to practice the claimed methods, since the results obtained for one embodiment would not necessarily extend to any of the other embodiments encompassed by the claims.

The teachings in the prior art and the post-filing art support this conclusion regarding the quantity of experimentation required to practice the claimed methods. For example, Feng et al. (Critical Reviews in Clinical Laboratory Sciences (2006) 43(5-6): 497-560; cited previously) teaches that although discovery of promising biomarkers occurs with much less experimental effort than previously, validation of clinical utility remains slow and difficult (page 537, last paragraph). Feng stated, "Biomarker discovery may require only a few weeks and a small number of patient samples, whereas its validation may require thousands of samples from multi-center trials (page 537, last paragraph)." Srinivas et al. (The Lancet (2001) 2: 698-704; cited previously) summarizes the extensive effort required to establish the diagnostic value of even a single biomarker in a single cancer in human subject, stating at pages 702-703:

The sensitivity, specificity, and predictive value of biomarkers have to be determined through use of body fluids, paired tumours, and surrounding tissue from a wide variety of cancers before they can be used in populations. Many samples from individuals with known characteristics should be processed, to minimize the problems of confounding and to avoid spurious associations. Before field-testing, it should be established that the biomarker is truly in the path of pathogenesis and not merely the result of an adaptive response. Case-control studies on stored samples should be used to test the efficiency of the biomarkers. Although the emerging technologies show great promise, care must be taken to define and establish references or baseline profiles from normal tissue, cells, or body fluids. Extensive animal studies may help refine human testing before screening. The biomarker assay should be reproducible to avoid false-positive and false-negative results and also to provide a substantial lead-time before clinical diagnosis.

Thus, the teachings in the art of Feng and Srinivas in combination with the teachings of Ma cited above support the conclusion that a large quantity of experimentation, with the use of many hundreds, perhaps even thousands, of subject samples would be necessary to practice the full scope of the claimed methods. These large sample sizes would be required for each different embodiment of the claimed methods (*i.e.* different HoxB13 sequences, different IL17BR sequences, different human populations, different antiestrogen agents, *etc.*). Each set of

experiments would be essentially independent from the others, and success in one set of experiments would not necessarily be predictive of success in another set of experiments. Furthermore, each set of experiments would be conducted with no guarantee of success.

The Level of skill in the art

The level of skill in the art is deemed to be high.

Conclusion

Given the complex nature of invention, the underdeveloped state of the art at the time of filing, and the limited nature of the disclosure, the ordinary artisan would be required to conduct a large quantity of unpredictable experimentation to practice the claimed methods. Accordingly, the methods of claims 6-8, 10-16, 18-25, 27-38, 42, 49, 50, 52-63, and 67-70 do not comply with the enablement requirement of 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 112, 1st paragraph (Written Description)

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-8, 10-16, 18-25, 27-38, 42, 49, 50, 52-63, 68, and 70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention. **This is a written description rejection.**

The central inquiry when considering written description is whether an ordinary artisan would reasonably conclude that Applicant was in possession of the claimed invention at the time of filing (see MPEP 2163 and *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1566-67, 43 USPQ2d 1398, 1404-05 (Fed. Cir. 1997); *Hyatt v. Boone*, 146 F.3d 1348, 1354, 47 USPQ2d 1128, 1132 (Fed. Cir. 1998)).

According to Revision I of the Written Description Training Materials (posted 4/11/08 at <http://www.uspto.gov/web/menu/written/pdf>), the following factors should be considered, when evaluating a claim for compliance with the written description requirement: (a) actual reduction to practice, (b) disclosure of drawings or structural chemical formulas (c) sufficient relevant identifying characteristics (d) method of making the claimed invention, (e) level of skill and knowledge in the art, and (f) predictability in the art (see page 1 of the Training Materials).

The instant claims 6-8, 10-13, 49, 50, 58, and 61 are drawn to a method of determining the risk of cancer recurrence in a human subject afflicted with ER(+) breast cancer based on the observed ratio of HoxB13 and IL17BR RNA expression levels. Claims 14-16, 18-22, 52, 53, 62, and 68 are drawn to a method of determining the clinical outcome of a human subject afflicted with ER(+) breast cancer an treated with an antiestrogen agent based on the observed ratio of HoxB13 and IL17BR RNA expression levels. Claims 23-25, 27-31, 54, 55, and 63 are drawn to a method of predicting the response of a human subject afflicted with ER(+) breast cancer to an antiestrogen agent based on the observed ratio of HoxB13 and IL17BR RNA expression levels. Claims 32-38, 42, 56, 57, 59, 60, and 70 are drawn to a method of determining the risk of cancer

recurrence in a human subject afflicted with ER(+) breast cancer if treated with an antiestrogen agent based on the observed ratio of HoxB13 and IL17BR expression levels.

The claims are extremely broad in scope. The methods of claims 6-8, 10-13, 58, and 61 encompass determining the risk of cancer recurrence or clinical outcome in ER(+) breast cancer human subjects of any age, ethnic population, and gender based solely on the observed ratio of the mRNA expression levels any HoxB13 sequence and any IL17BR sequence, where any expression level ratio higher than the average ratio of HoxB13 and IL17BR RNA expression levels in ER(+) breast cancer cells is indicative of cancer recurrence. Claims 49 and 50 further limit the HoxB13 and IL17BR sequences to SEQ ID NO: 6 and SEQ ID NO: 1, respectively.

Claims 14-16, 18-22, and 62 encompass determining clinical outcome in human subjects of any age, ethnic population, and gender based solely on the observed ratio of the mRNA expression levels any HoxB13 sequence and any IL17BR sequence, where any expression level ratio higher than the average ratio of HoxB13 and IL17BR RNA expression levels in ER(+) breast cancer cells is indicative of cancer recurrence. The methods of claims 14-16 and 18-22 are also not limited to patients having ER(+) breast cancer and comprise treatment of the subjects with any antiestrogen agent. Claims 52 and 53 further limit the HoxB13 and IL17BR sequences to SEQ ID NO: 6 and SEQ ID NO: 1, respectively, and claim 68 further limits the antiestrogen agent to tamoxifen.

The methods of claims 23-25, 27-31 and 63 encompass predicting the response of ER(+) breast cancer human subjects of any age, ethnic population, and gender to treatment with any antiestrogen agent based solely on the observed ratio of the mRNA expression levels any HoxB13 sequence and any IL17BR sequence, where any expression level ratio higher than the

average ratio is indicative of a positive response to treatment. Claims 54 and 55 further limit the HoxB13 and IL17BR sequences to SEQ ID NO: 6 and SEQ ID NO: 1, respectively.

The methods of claims 32-38, 42, 59, and 60 encompass determining the risk of cancer recurrence in human ER(+) breast cancer subjects of any age, ethnic population, and gender if treated with any antiestrogen agent based solely on any observed increase in the RNA expression levels of any HoxB13 sequences (*i.e.* wild-type or any variant sequence) or any observed decrease in the RNA or expression levels of any IL17BR sequences (*i.e.* wild-type or any variant sequence). Claims 56 and 57 further limit the HoxB13 and IL17BR sequences to SEQ ID NO: 6 and SEQ ID NO: 1, respectively, and claim 70 further limits the antiestrogen agent to tamoxifen.

The specification teaches that the ratio of HoxB13 and IL17BR RNA expression can be used to determine a risk of cancer recurrence, predict clinical outcome, and predict the responsiveness of any human subject to treatment with an antiestrogen agent (see pages 9-12 and 55, for example). The specification also teaches that any change in the ratio compared to the average ratio is sufficient for prediction and risk assessment (see pages 17-18, for example). The specification further teaches that the methods can be used to predict the responsiveness of a subject to any antiestrogen agent (see pages 15-16, for example). Finally, the specification provides a number of HOXB13 and IL17BR sequences and teaches that "any sequence, or unique portion thereof, of the following IL17BR sequence, identified by AF208111 or AF208111.1, may be used in the practice of the invention" and goes on to disclose the IL17BR sequence of SEQ ID NO: 3 (see pages 34, lines 2-4 and SEQ ID NO:3 on page 34-35). Similarly, the specification teaches that "any sequence encoding all or part of the protein encoded by any IL17BR sequence disclosed herein may be used (page 29, lines 4-10)."

In Example 1, the specification teaches that a 22,000-gene high-density oligonucleotide microarray was used to determine gene expression patterns from 60 ER+ breast cancer patients who were uniformly treated with tamoxifen (see page 60, line 20 - page 61, line 14). The IL17BR and HOXB13 oligonucleotide sequences used in the microarray are undisclosed. In Example 2, the specification teaches that from the resulting data set, 5,475 genes were selected for further analysis and that using this reduced dataset, a t-test was performed on each gene comparing "the tamoxifen responders and non-responders, leading to identification of 19 differentially expressed genes at the P value cutoff of 0.001 (Table 2)", including HOXB13 and IL17BR (see page 65, lines 5-15). Then, to further refine the analysis, the specification teaches that the same cohort was reanalyzed following laser-capture microdissection of tumor cells within each tissue section and 9 differentially expressed gene sequences were identified with P0.001, again including HOXB13 and IL17BR (see page 66, lines 2-6 and Table 3). The specification teaches that HOXB13, IL17BR, and CACNAID expression levels were found to be significantly correlative in both the LCM and whole tissue section samples (see, *e.g.*, page 67, lines 3-10). The specification further states that "...these three genes have potential utility for predicting clinical outcome of adjuvant tamoxifen therapy (page 68, lines 6-7)." Finally, the specification discloses that the HOXB13 and IL17BR expression ratio is a "strong independent predictor of treatment outcome in the setting of adjuvant tamoxifen therapy (see, *e.g.*, page 70, lines 5-7)."

However, the working examples do not teach the use of the HOXB13 and IL17BR expression ratio outside the setting of adjuvant tamoxifen therapy (*e.g.* to predict a risk of cancer recurrence or the responsiveness of a subject having any other type of breast cancer to any other

antiestrogen agent). The specification also does not teach what levels of mRNA expression of HOXB13 and IL17BR sequences are required such that the ratio is indicative of responsiveness to a particular treatment, clinical outcome, or the risk of cancer recurrence. The working examples also do not address the ability of the expression ratio to be used in different human populations (*e.g.* different ethnic populations, age groups, or male and female breast cancer patients) or whether the ratios of any different HoxB13 and IL17BR sequences can be used to predict the risk of cancer recurrence, clinical outcome, or responsiveness to antiestrogen treatment.

As a result, the specification does not adequately describe the claimed methods of determining the risk of cancer recurrence, clinical outcome, or responsiveness of any human subject to treatment with any antiestrogen agent based on the expression ratio of any HoxB13 and IL17BR RNA sequences. As discussed above, the working examples are limited to a single embodiment of the claimed methods conducted using a small sample size. The working examples do not extend the results to any other embodiments encompassed by the claims. In other words, the specification does not adequately describe a representative number of species within the very large genus encompassed by the claims. The specification also fails to teach the relevant identifying characteristics required to satisfy the written description requirement, since it contains no discussion of validation methods or strategies expected to be useful in determining which antiestrogen agents, human populations, *etc* are expected to be capable of functioning in the claimed methods. As discussed above, the claimed methods are associated with a high level of unpredictability, and as a result, the level of skill in the art required to practice the claimed methods is high. Also, as discussed above, the claimed methods were unknown in the prior art at

the time of filing. Therefore, it must be concluded that Applicant was not in possession of the full scope of the claimed methods at the time of filing.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 6-8, 10-16, 18-25, 27-38, 42, 49, 50, 52-63, and 67-70 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-43 of U.S. Patent No. 7,504,214 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other, because the methods recited in claims 1-43 of the '214 patent recite a species of the methods recited in the instant claims 6-8, 10-16, 18-25, 27-38, 42, 49, 50, 52-63, and 67-70. Accordingly, the methods recited in claims 1-43 of the '214 patent anticipate the methods of the instant claims 6-8, 10-16, 18-25, 27-38, 42, 49, 50, 52-63, and 67-70.

10. Claims 6-8, 10-16, 18-25, 27-38, 42, 58-63, and 67-70 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 9-27 of co-pending Application No. 11/089,097. Although the conflicting claims are not identical, they are not patentably distinct from one another, because the methods recited in claims 1 and 9-27 of the '097 application recite all of the limitations of the instant claims 6-8, 10-12, 14-16, 18-20, 23-25, 27-29, 32, 35, 36, 38, 42, and 59-62. Accordingly, the methods recited in claims 1 and 9-27 of the co-pending '097 application anticipate the methods recited in the instant claims 6, 7, 9-12, 14, 15, 17-20, 32, 33, 35, 36, 38, 42, 59-63, and 67-70.

The claims of the '097 application do not recite the limitations of the instant claims 13, 21, 22, 30, 31, 34, 37, and 58, which require analysis of particular samples. However, it would have been *prima facie* obvious for an ordinary artisan practicing the methods recited in the claims of the '097 application to utilize any sample known to be useful for determining mRNA expression levels, such as the samples recited in the instant claims 13, 21, 22, 30, 31, 34, 37, and 58. An ordinary artisan practicing the method recited in the claims of the '097 application would have recognized that such samples were suitable for practicing the methods recited in the '097 application, and therefore, would have been motivated to analyze them with a reasonable expectation of success. As noted in MPEP 2144.07, it is *prima facie* obvious for one of ordinary skill in the art at the time of invention to select a known material based on its suitability for the intended purpose in the absence of unexpected results. In this case, no evidence has been presented to suggest that the use of the samples recited in the instant claims 13, 21, 22, 30, 31, 34, 37 and 58 is associated with unexpected results. Thus, claims 1 and 9-27 of the '097

application are **not** patentably distinct from the instant claims 6-8, 10-16, 18-25, 27-38, 42, 58-63, and 67-70.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 6-8, 10-16, 18-25, 27-38, 42, 58-63, and 67-70 are directed to an invention not patentably distinct from claims 1 and 9-27 of commonly assigned Application Serial No. 11/089,097. Specifically, as discussed above, the methods of the instant claims 6-8, 10-16, 18-25, 27-38, 42, 58-63, and 67-70 are either anticipated by or an obvious variant of the methods recited in claims 1 and 9-27 of the '097 application.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned Application No. 11/089,097, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly

assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Response to Arguments

12. Applicant's arguments filed on November 30, 2009 have been fully considered, and they are persuasive, in part.

Claim Objections

Applicant's arguments, see page 10, filed on November 30, 2009, regarding the previously made objections to claims 6, 7, 9, 14, 15, 17, 23, 24, 26, 32, 38, and 61-63, have been fully considered and are persuasive. Applicant states that the claim amendments have obviated the previously made objections (see page 10). The Examiner agrees, and accordingly, the previously made objections have been withdrawn. However, as discussed above, the claim amendments have necessitated new objections to claims 12, 35, 49, 50, 52-57, 59, 60, and 67-70.

Rejection under 35 U.S.C. 112, second paragraph

Applicant's arguments, see page 11, filed on November 30, 2009, regarding the previously made rejections of claims 32-38, 42, 56, 57, 59, 60, and 70 under 35 U.S.C. 112, second paragraph have been fully considered, and they were persuasive in part. Applicant argues that the claim amendments have obviated the previously made rejections (page 11). This argument was persuasive with respect to claims 32-38, 56, 57, 59, and 60, and accordingly, the previously made rejection has been withdrawn. This argument was not persuasive with respect

to claims 42 and 70, however, because the claim amendment has not corrected the antecedent basis problem in claim 42 from which claim 70 depends. Since the limitation "the ratio" in claim 42 continues to lack proper antecedent basis, the rejection of claims 42 and 70 under 35 U.S.C. 112, second paragraph has been maintained. Also, the claim amendments have necessitated the new rejections of claims 38, 49, 50, 52-57, and 60-63 under 35 U.S.C. 112, second paragraph.

Rejection under 35 U.S.C. 112, 1st paragraph (new matter)

Applicant's arguments, see page 11, filed on November 30, 2009, regarding the previously made rejection of claims 23-31, 54, 55, 63, and 69 under 35 U.S.C. 112, first paragraph (new matter), have been fully considered, and are persuasive. Applicant argues that the rejection has been obviated by the claim amendments (page 11). The Examiner agrees, and accordingly, the rejection has been withdrawn. It is noted, though, that upon further consideration, a new rejection on the ground of new matter has been made above.

Rejection under 35 U.S.C. 112, 1st paragraph (enablement)

Applicant's arguments filed on November 30, 2009, regarding the rejection of claims 6-38, 42, 49, 50, 52-63, and 67-70 under 35 U.S.C. 112, first paragraph (enablement), as they apply to the new ground of rejection, where claims 6-8, 10-16, 18-25, 27-38, 42, 49, 50, 52-63, 68, and 70 have been under 35 U.S.C. 112, first paragraph (lack of enablement), have been fully considered, and they were persuasive, in part.

Applicant first argues that claims are presumed to be enabled unless there is an objective reason for doubt, and that the required objective reason for doubt has not been articulated in the

rejection (see pages 15-16). This argument was not persuasive, because as discussed in greater detail above, the teachings of the references cited in the rejection clearly establish an objective reason for questioning whether the full scope of the claimed methods is enabled by the disclosure.

Applicant also argues that none of the references cited in the rejection relate to HoxB13 or IL17BR RNA expression levels in relation to breast cancer (page 11, last paragraph - page 12, first paragraph). Applicant argues, therefore, that the cited references do not provide an objective reason for questioning the enablement of the claimed methods, which relate to the use of HoxB13:IL17BR expression levels in the assessment of breast cancer patients (page 11, last paragraph - page 12, first paragraph).

This argument was not persuasive, because the post-filing art of Ma (Cancer Cell 2004) cited in the rejection directly relates to the use of HoxB13 and IL17BR expression levels to assess breast cancer recurrence after tamoxifen treatment, and therefore, is highly relevant when considering whether the disclosure of the instant application enables the full scope of the claimed methods. As discussed above, the disclosure of Ma is much narrower in scope than the claims, since Ma only teaches that the ratio of HoxB13:IL17BR mRNA expression levels can be used to accurately predict tumor recurrence in tamoxifen-treated patients with early-stage ER-positive breast cancer and does not extend the results to assessing clinical outcome, non-ER+ breast cancer patients, or predicting responsiveness to other antiestrogen agents as recited in the instant claims. Furthermore, as noted above, Ma expressly cautions against over-extending the observed results, noting that the findings are preliminary and that additional research must be conducted (see pages 611-613). Thus, the teachings of Ma would have led the ordinary artisan to

objectively question whether the full scope of the claimed methods is enabled by the disclosure of the instant application.

Also, although Applicant is correct that the other non-patent literature references cited in the enablement rejection do not relate to the use of HoxB13 or IL17BR expression levels in assessing breast cancer, they are still relevant to the consideration of whether the claimed methods are supported by an enabling disclosure, since they are directed to a similar problem, namely the use of gene expression signatures to assess complicated diseases. Like Ma, the additional references cited in the rejection establish the level of skill in the art at the time of the invention and demonstrate that methods similar to the claimed methods are associated with a high degree of unpredictability and require the performance of a large quantity of non-routine and unpredictable experimentation.

Applicant further argues that the rejection contains only unsupported allegations and that the inclusion of claims 67-70 in the enablement rejection is illustrative of the unsupported and subjective nature of the rejection (see page 12).

These arguments have been fully considered, and they were persuasive, in part. In contrast to Applicant's arguments at page 12, the conclusions contained in the enablement rejection are not unsupported allegations, since are properly supported by the teachings of the non-patent literature references cited in the rejection. Applicant's arguments at page 12 regarding the inclusion of claims 67-70 in the rejection were persuasive with respect to claims 67 and 69, and accordingly, these claims have not been included in the present rejection. Applicant's arguments at page 12 were not persuasive with respect to claims 68 and 70, however, because these claims are broader in scope than the previously patented claims of the '214 patent

to which Applicant is presumably referring in the response. Accordingly, inclusion of claims 68 and 70 in the enablement rejection is not inconsistent and does not indicate that the enablement rejection is entirely subjective in nature.

Since Applicant's arguments were not persuasive, the rejection has been maintained with minor modifications to address the claim amendments.

Rejection under 35 U.S.C. 112, 1st paragraph (written description)

Applicant's arguments filed on November 30, 2009, regarding the rejection of claims 6-38, 42, 49, 50, 52-63, and 67-70 under 35 U.S.C. 112, first paragraph (enablement), as they apply to the new ground of rejection, where claims 6-8, 10-16, 18-25, 27-38, 42, 49, 50, 52-63, 68, and 70 have been under 35 U.S.C. 112, first paragraph (written description), have been fully considered, but they were not persuasive.

Applicant argues that the entire basis of the rejection appears to be that the specification lacks an actual reduction to practice of the claimed methods, which is not required to satisfy the written description requirement of 35 U.S.C. 112, first paragraph (page 12).

This argument was not persuasive, because the rejection is not based solely on the fact that the specification lacks an actual reduction to practice of the claimed methods. As discussed in the rejection, assessment of compliance with the written description requirement of 35 U.S.C. 112, first paragraph requires consideration of the following factors: (a) actual reduction to practice, (b) disclosure of drawings or structural chemical formulas (c) sufficient relevant identifying characteristics (d) method of making the claimed invention, (e) level of skill and knowledge in the art, and (f) predictability in the art (see page 1 of the Written Description

Training Materials, Revision I , which was posted on April 11, 2008 at <http://www.uspto.gov/web/menu/written/pdf>). In this case, as discussed above, the specification lacks an actual reduction to practice of the claimed methods and also fails to identify the relevant identifying characteristics necessary to practice the full scope of the claimed methods. Also, the claimed methods are associated with a high degree of unpredictability and require a high level of skill in the art for their successful practice. The combination of a highly unpredictable art and a minimal disclosure with respect to the claimed methods has prompted the written description rejection. Since Applicant's arguments were not persuasive, the rejection has been maintained with minor modifications to address the claim amendments.

Rejection on the ground of non-statutory obviousness-type double patenting

Regarding the previously made rejection of claims 6-22, 32-38, 42, 49, 50, 52, 53, 56-62, 67, 68, and 70 on the ground of non-statutory obviousness-type double patenting citing US 7,504,214 B2, Applicant requests that the rejection be held in abeyance the instant claims are otherwise allowable (see pages 12-13). Applicant's remarks have been noted. In view of the amendment, the rejection currently applies to claims 6-8, 10-16, 18-25, 27-38, 42, 49, 50, 52-63, and 67-70. Since a terminal disclaimer has not been filed and since the amended claims are not patentably distinct from the claims of the '214 patent, the rejection has been maintained with minor modifications to address the claim amendments.

Provisional rejection on the ground of non-statutory obviousness-type double patenting

Regarding the provisional rejection of claims 32-37, 42, 59, and 60 on the ground non-statutory obviousness-type double patenting citing co-pending Application Serial No. 11/089,097, Applicant requests that the rejection be held in abeyance until the instant claims are otherwise allowable (see pages 12-13). Applicant's remarks have been noted. In view of the amendment, the provisional rejection currently applies to claims 6, 7, 9-15, 17-22, 32, 34-38, 42, and 58-62. Since the provisional obviousness-type double patenting rejection is not the only issue remaining in either the instant application or the '097 application, the amended claims of the instant application are not patentably distinct from the claims of the '097 application, and since a terminal disclaimer has not been filed, the provisional rejection has been maintained in accordance with the guidance provided in MPEP 804.

Conclusion

13. No claims are currently allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANGELA BERTAGNA whose telephone number is (571)272-8291. The examiner can normally be reached on M-F, 9- 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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/Angela M Bertagna/
Examiner, Art Unit 1637

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